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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,276	04/24/2000	Fred S. Cook	1352	8008

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EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

DATE MAILED: 06/14/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,276

Applicant(s)

COOK, FRED S.

Examiner

Syed Zia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 25, 27, 29, 33, 35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 27, 29, 33, 35, and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 08, 2004 (Paper No. 8) has been entered and made of record.

Response to Amendment

This is response to amendment filed on March 03, 2004 (Paper No. 8). Applicant cancelled 26, 28, 30-32, 34, 36, and 38-40. The amendment filed have been entered and made of record. Presently pending claims are 25, 27, 29, 33, 35, and 37.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 25, and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claim 25:

- if the prepaid account code is not associated with the first access provider, **transferring the prepaid account code to a foreign database system of a second access provider;**

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- in the foreign database system, processing the prepaid account code to determine if the prepaid account is associated with the second access provider; and

Claim 33 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claim limitations.

(2) Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

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Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 25, 28, 33, and 36.

-the local database system configured to process the prepaid account code to determine if the prepaid account code is associated with the first access provider; **and transfer the prepaid account code to a foreign database system of a second access provider if the prepaid account code is not associated with the first access provider;**

- the foreign database system configured to process the prepaid account code to determine if the prepaid account code is associated with the second access provider.

Response to Arguments

Applicant argued that cited prior art (CPA) [Toader et al., U.S. Pat. No. 5,749,075] does not teach the claimed invention as indicated independent and dependent claims (Paper No.9 dated March 08, 2004).

Applicant's request for consideration has been fully considered but they are not persuasive because of the following reasons:

CPA clearly teaches and describes a method that provides a PIN number, or access code to the user, which entitles the user to log on to an Internet entry server. The user is prompted to answer a series of queries. This allows the user to access the services for a predetermined time once the user has responded to all the queries. Thus, CPA provides paid service connect time allotment to user after authenticating the user.

CPA clearly teaches and describes access communication system that provides access between a user system and plurality of communication networks.

In summary, the examiner asserts that the cited CPA teaches or suggests an access communication system, as claimed and recited in various independent and dependent claims.

Applicants still have failed to disclose the novelty of the invention and point out specific claimed limitations that would define a patentable distinction over cited prior arts. Therefore, the examiner asserts that CPA does teach or suggest the subject matter broadly recited in independent claims 25, and 33. Dependent claims 27, 29, 35, and 37 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action (Paper No. 10). Accordingly, rejections for Claims 25, 27, 29, 33, 35, and 37 are respectfully maintained

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 25, 27, 29, 33, 35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Toader et al. U. S. Patent 5,749,075.
2. Regarding Claim 25 Toader teaches a method of providing Internet access to a network device through a first access provider, the method comprising:

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- transmitting a logon query from the access server to the network device, and in the access server, receiving a logon response from the network device to gain the internet access through the first access provider and wherein the logon response includes a prepaid account code; transferring the prepaid account code from the access server to a local database system of the first access provider (col.3 line 6 to line 32, and col.5line 49 to col.6 line 39);

- in the local database system, processing the prepaid account code to determine if the prepaid account code is associated with the first access provider (col.5 line 49 to line 65);

- if the prepaid account code is associated with the first access provider, providing internet access to the network device through the first access provider (col.5 line 49 to col.6 line 32);

- if the prepaid account code is not associated with the first access provider, transferring the prepaid account code to a foreign database system of a second access provider (col.3 line 48 to line 50);

- in the foreign database system, processing the prepaid account code to determine if the prepaid account is associated with the second access provider; and if the prepaid account code is associated with second access provider, providing internet access to the network device through the access server of the first access provider (col. 5line 49 to line 53, and col. 6line 8 to line 32).

3. Regarding Claim 33 Toader teaches system for providing Internet access to a network device through a first access provider, the system comprising:

- an access server of the first access provider configured to transmit a logon query from the access server to the network device, receive logon response from the network device to gain

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the internet access through the first access provider wherein the logon response includes a prepaid account code, and transfer the prepaid account code from the access server to a local database system of the first access provider (col.3 line 6 to line 32, and col.5 line 49 to col.6 line 39);

- the local database system configured to process the prepaid account code to determine if the prepaid account code is associated with the first access provider (col.5 line 59 to line 65); and transfer the prepaid account code to a foreign database system of a second access provider if the prepaid account code is not associated with the first access provider (col.5 line 4 to line 39);

- the foreign database system configured to process the prepaid account code to determine if the prepaid account code is associated with the second access provider (col. 5 line 28 to line 38);

- the access server of the first access provider configured to provide Internet access to the network device if the prepaid account code is associated with the first access provider and provide internet access to the network device if the prepaid account code as associated with the second access provider (col.5 line 59 to col.6 line 7).

5. Claims 27, 29, 35, and 37 are rejected applied as above rejecting Claims 25, and 33.

Furthermore, Toader teaches and describes wherein:

- if the network device is not allowed to access the Internet, transferring a decline message to the access server (col.3 line 48 to line 50);

- the prepaid account code is linked to a prepaid account and wherein the prepaid account code is displayed on a prepaid account card and wherein the second access provider provides the

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prepaid account card to a user and wherein the user utilizes the network device and the prepaid account card to access the internet (col.5 line 4 to line 39);

- the local database system is further configured to transfer a decline message to the access server if the network device is not allowed to access the Internet through the first access provider (col.3 line 48 to line 50);

- the prepaid account code is linked to a prepaid account and wherein the prepaid account code is displayed on a prepaid account card and wherein the second access provider provides the prepaid account card to a user and wherein the user utilizes the network device and the prepaid account card to access the internet (col.5 line 4 to line 39).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ
June 6, 2004


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